

R E M A R K S

Claims 1, 3, 4, 11, and 19 are amended. Claim 2 is canceled. Claims 5-10, 12-18, and 20 stand as originally filed. Re-examination and reconsideration are requested.

5 In the office action, paper number 4, dated June 10, 2004, the examiner objected to the title of the invention as not being descriptive. The examiner rejected claims 1-10 under 35 U.S.C. §112, second paragraph, for the reasons stated in section 3 of the office action. The examiner rejected claims 1, 4-7, 10-13, 10 and 15-20 under 35 U.S.C. §102(e) as being anticipated by Brady, et al., U.S. Patent No. 6,201,474 (Brady). The examiner rejected claims 2, 3, 8, 9, and 14 under 35 U.S.C. §103(a) as being unpatentable over Brady for the reasons stated in section 9 of the office action.

15 Re the Specification:

The title of the invention is amended in accordance with the examiner's suggestion. No new matter is added.

Re the Claims:

20 Claims 1 and 11 are amended to include the limitations previously contained in claim 2 (now canceled). No new matter is added. Claim 1 is also amended to change the term "control system" to "controller."

Claim 3 is amended to change its dependency in light of the cancellation of claim 2.

25 Claim 4 is amended to make it consistent with the amendments to claim 1.

Claim 19 is amended to include the elements and limitations as specifically set forth therein. Support for the amendments to claim 19 is found throughout the specification and claims as originally filed and specifically at, for example, page 7, line 30 27 through page 10, line 4.

Re the Objections to the Title:

The examiner objected to the title as not being descriptive of the invention. Applicants respectfully disagree. However, because the examiner's proposed title is also descriptive of the invention, and in order to more rapidly resolve the issue, applicants have amended the title of the invention in accordance with the examiner's proposed title. It is believed that the amended title overcomes the examiner's objections.

Re the Section 112 Rejections:

The examiner rejected claims 1-10 under 35 U.S.C. §112, second paragraph, in that the term "control system" in claim 1 lacked the proper antecedent basis. Applicants have amended claim 1 to change the term "control system" to "controller," which does have the proper antecedent basis. It is believed that this amendment to claim 1 overcomes the examiner's rejections of claims 1-10.

Re the Section 102 and 103 Rejections:

The examiner rejected claims 1, 4-7, 10-13, and 15-20 under 35 U.S.C. §102(e) as being anticipated by Brady. The examiner rejected claims 2, 3, 8, 9, and 14 under 35 U.S.C. §103(a) as being unpatentable over Brady.

Re the Section 102 Rejections:

The examiner rejected claims 1, 4-7, 10-13, and 15-20 as being anticipated by Brady. However, these rejections are moot based on the amendments to claims and will not be discussed in further detail herein.

With respect to the amended claims, independent claims 1 and 11 now require that the cartridge access device include a cartridge plunge mechanism and that the reader is mounted to the cartridge plunge mechanism. As the examiner noted in section 9 of the office action, the Brady reference does not meet at least this limitation. To the contrary, Brady mounts the interrogator

320 to the shelving apparatus 300, not to the media retrieval/return mechanism 322. See Figure 10 of Brady. Consequently, Brady cannot anticipate amended claims 1 and 11.

Independent claim 19 is also not anticipated by Brady. Claim 19, as amended, includes "means, mounted to said cartridge plunge means, for generating the query and for receiving transmitted data." Here again, because Brady's interrogator 320 is not mounted to his media retrieval/return mechanism 322, Brady cannot be said to anticipate amended claim 19.

Dependent claims 2-10, 12-18, and 20 are also not anticipated by Brady, in that they depend from claims 1, 11, and 19, which are not anticipated by Brady.

Re the Section 103 Rejections:

The examiner rejected claims 2, 3, 8, 9, and 14, under Section 103(a) as being obvious over Brady for the reasons set forth in section 9 of the office action. However, these rejections are now moot in light of the amendments to the claims and will not be discussed in further detail herein.

With respect to the amended claims, amended claims 1-20 all require that the reader be mounted to the cartridge plunge mechanism (or the cartridge plunge means in claims 19 and 20). These claimed limitations are not taught or suggested in Brady. As mentioned above, Brady does not mount his interrogator 320 to the media retrieval/return mechanism 322. See Figure 10. While the examiner has taken the position that it would have been "an obvious matter of design choice" to modify Brady to mount the reader to the cartridge access device, this position is unfounded in light of the teachings of Brady. First, by mounting the interrogator 320 at a location other than on the media retrieval/return mechanism 322, Brady teaches away from the arrangement of the present invention. A reference that teaches away from an invention may not properly be used in framing an obviousness rejection under Section 103. See United States v. Adams, 148 USPQ 429 (1966).

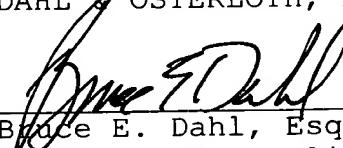
In addition, Brady contains no mention of the problems (i.e., interference and tolerance issues) identified by the disclosure of the present invention, much less solutions to those problems (see, for example, page 5, line 29 to page 6, line 22).
5 Therefore, a person having ordinary skill in the art, and faced with the problems of the present invention, would find nothing in Brady that would provide the suggestion or incentive required to modify the structural arrangement of the Brady device in the manner required by the pending claims. Indeed, because the
10 arrangement of Brady is presumably functional for its intended purpose, there is no need in Brady, thus no suggestion or incentive, to mount Brady's interrogator 320 on his media retrieval/return mechanism 322.

In summation, then, because Brady fails to provide the
15 suggestion or incentive to a person having ordinary skill in the art to modify Brady in the manner required by the pending claims, Brady cannot be used to establish the required *prima-facie* case of obviousness. Consequently, Brady cannot make obvious the claims of the present invention.

20 Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues
25 remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

DAHL & OSTERLOTH, L.L.P.

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